

REMARKS

The Office Action mailed July 19, 2006 considered and rejected claims 21-28, 35-41 and 45-47. Claim 21 was rejected under 35 U.S.C. 102(e) as being anticipated by Klein (US 6,631,398) and claims 22-28, 35-41, 45-47 were rejected under 35 U.S.C. 103(a) as being unpatentable over Klein (US 6,631,398) in view of Kelly (US 6,138,168).¹

By this amendment, claims 21, 35, and 45 have been amended such that claims 21-28, 35-41 and 45-47 remain pending. Claims 21, 35 and 45 are the only independent claims which remain at issue.

As reflected above, in the claim listing, the present invention is generally directed towards organizing email replies. In some embodiments, as described in the specification, thread-based email methods and systems can also be used to reduce the computing resources necessary for processing and storing messages and for improving the organization of responses to electronic messages. See Specification ¶ 2. One benefit of the present invention is that inefficient duplication of messages can be avoided by assigning unique identifiers and storing messages in accordance with the methods and systems particularly pointed out in the Specification and in the claims. See Specification ¶¶ 9-10, 16-22.

Klein, the primary reference used to anticipate the claims is distinguished from the claims and is actually directed towards different embodiments than those of the present invention altogether. In particular, *Klein* is directed towards "managing messages so that redundant messages need not be reviewed by a user." See *Klein* col. 2, lines 17-28. Notably, *Klein* does not address the avoidance of storage duplication. Instead, *Klein* specifically teaches that messages associated with replies be duplicated with the reply messages in exactly the inefficient manner the present invention is designed, at least in part, to cure. See *Klein* Claim 7, col. 11, lines 60-67.

It should also be noted that *Klein* teaches that electronic message management is to be conducted on a user-by-user basis. See *Klein* col. 6, lines 15-37 and col. 8, lines 33-44. The invention taught by *Klein* may only be used to effect efficiencies on a per-user basis. Nothing is disclosed by *Klein*, as is pointed out in the current application, which can be employed on a

¹ Although the prior art status of the cited art is not being challenged at this time, Applicant reserves the right to challenge the prior art status of the cited art at any appropriate time, should it arise. Accordingly, any arguments and amendments made herein should not be construed as acquiescing to any prior art status of the cited art.

system or server basis to reduce redundancies as applied to multiple users. *See* Specification ¶ 19.

It is for at least these reasons and those more particularly pointed out below that the Applicant believes that the present invention, as disclosed within the specification and particularly pointed out in the claims, are not fully anticipated by *Klein* nor are obvious in view of *Kelly* in light of *Klein*.

Concerning Claim 21:

The Examiner cites to *Klein* for anticipation of Claim 21 under 35 U.S.C. § 102. However, *Klein* specifically teaches that "the contents of the response electronic message includ[es] the contents of the electronic message" (*See Klein* col. 11, lines 65-67) (and thus the unavoidable duplication of messages) which is precisely one of the inefficiencies the present invention is designed to overcome. Contrary to *Klein*, the present invention teaches that messages need not be duplicated if intended for multiple recipients or if associated with multiple replies. *See* Specification ¶¶ 5-9, 14-16, 32.

It should be noted that the functionality disclosed by *Klein* operated on a user-by-user basis. *See Klein* col. 6, lines 15-37 and col. 8, lines 33-44. In *Klein*, a message is considered redundant, and therefore subject to deletion or other management only if the same message is redundant in light of other new or pending messages for a particular user. *See Klein* col. 6, lines 15-37; col. 8, lines 33-44; col. 7, line 66 to col. 8, line 6. In the present invention, and contrary to *Klein*, efficiencies are gained by management of messages which are intended for multiple, distinct, recipients. *See* Specification ¶¶ 13-19.

Claim 21 has been amended to more particularly point out this disclosed functionality.² By this amendment to Claim 21, the claims and disclosure of *Klein* are now distinct from (and, in fact, directly contrary to) the innovation taught and claimed in the present invention. As such, each and every limitation of Claim 21 is not taught by *Klein* and so rejection under 35 U.S.C. § 102 is no longer appropriate and Claim 21 should now be in condition for prompt allowance. Accordingly, the Applicant respectfully requests that the Examiner withdraw the rejection under 35 U.S.C. § 102 to Claim 21 and issue its allowance.

² The Applicant requests the Examiner look to those claims as allowed in Application 09/399,417. This Application is a divisional application of application 09/399,417.

Concerning Claims 22-28:

Claims 22-28 are dependent claims dependent upon Claim 21. As the rejection of Claim 21 should now be moot, Claims 22-28 should now be in condition for prompt allowance. Accordingly, the Applicant respectfully requests that Claims 22-28 be allowed.

Concerning Claims 35 and 45:

Independent claims 35 and 45 were rejected based, at least in part, on the same prior art cited from *Klein* as is discussed, above, under Claim 21. As such, the discussion of Claim 21 applies equally to Claims 35 and 45. Claims 35 and 45 have similarly been amended to particularly point out limitations not taught by *Klein* (and, indeed, specifically taught away from by *Klein*) and so rejection under 35 U.S.C. § 102 is no longer inappropriate. Similarly, rejection under 35 U.S.C. § 103 is no longer appropriate because *Kelly* (US 6,138,168) cannot supply a limitation, over *Klein*, which *Klein*, itself specifically teaches against.³ As such, Claims 35 and 45 should now be in condition for prompt allowance. Accordingly, the Applicant respectfully requests the Examiner withdraw rejections of Claims 35 and 45 based on *Klein* and based on *Kelly* in view of *Klein* and the Applicant respectfully requests Claims 35 and 45 now be allowed.

Concerning Claims 36-41:

Claims 36-41 are dependent claims dependent upon Claim 35. As the rejection of Claim 35 should now be moot, Claims 36-41 should now be in condition for prompt allowance. Accordingly, the Applicant respectfully requests that Claims 36-41 be allowed.

Concerning Claims 46-47:

Claims 46-47 are dependent claims dependent upon Claim 45. As the rejection of Claim 45 should now be moot, Claims 46-47 should now be in condition for prompt allowance. Accordingly, the Applicant respectfully requests that Claims 46-47 be allowed.

In view of the foregoing, Applicants respectfully submit that the other rejections to the claims are now moot and do not, therefore, need to be addressed individually at this time. It will be appreciated, however, that this should not be construed as Applicants acquiescing to any of the purported teachings or assertions made in the last action regarding the cited art or the pending application, including any official notice. Instead, Applicants reserve the right to challenge any of the purported teachings or assertions made in the last action at any appropriate time in the

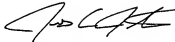
³ Klein specifically teaches that the original message is *contained within* a response message. See *Klein* Claim 7, col 11, lines 65-67.

future, should the need arise. Furthermore, to the extent that the Examiner has relied on any Official Notice, explicitly or implicitly, Applicants specifically request that the Examiner provide references supporting the teachings officially noticed, as well as the required motivation or suggestion to combine the relied upon notice with the other art of record.

In the event that the Examiner finds remaining impediment to a prompt allowance of this application that may be clarified through a telephone interview, the Examiner is requested to contact the undersigned attorney.

Dated this 19th day of October, 2006.

Respectfully submitted,



RICK D. NYDEGGER
Registration No. 28,651
JENS C. JENKINS
Registration No. 44,803
Attorneys for Applicant
Customer No. 047973

JCJ:ged:ahy
AHY0000001794V001